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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,040	11/26/2003	Keith C. Hullfish	AOL0126	7812
22862	7590	06/26/2006	EXAMINER	
GLENN PATENT GROUP 3475 EDISON WAY, SUITE L MENLO PARK, CA 94025			BHATIA, AJAY M	
			ART UNIT	PAPER NUMBER
			2145	

DATE MAILED: 06/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/723,040

Applicant(s)

HULLFISH ET AL.

Examiner

Ajay M. Bhatia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/7/06, 5/17/06</u> | 6) <input type="checkbox"/> Other: _____  |

### ***Response to Arguments***

Applicant's arguments filed 5/17/06 have been fully considered but they are not persuasive.

Applicant has requested further clarification of both Double Patenting and 101 rejection which is provided bellow.

Applicant states for 102, rejection not understanding the presently cited prior art. Examiner suggest that reading the reference in whole will give better understanding in the context of the prior art cited. Additionally applicant discusses determining, the routing of the message which Mache discusses in paragraphs 9, 10, 19, 43, 52 the appropriate transmission medium is selected by the system. In figure 4 of Mache the prior art shows the different types of transmission mediums connected to the system. Specifically in paragraphs 52, 53, 57 Mache discuss that state of the device information, which is used to determine the routing of the messages. Therefore the examiner is not persuaded the rejection is made final

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

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1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 22, 42 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,12,15 of U.S. Patent No. 6,714,793. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the narrower claims in the Patent anticipates the broader claims of the current pending application. Exemplarily claims 1 from both applications is provided bellow.

Patent 6,714,793	Instant application 10/0723,040	
A method for instant text message communication, said method comprising: sending an instant text message from a cellular communications device in wireless communication	1. A method of transmitting electronic messages in a computer environment, comprising the steps of: receiving an electronic message addressed to a telephone number;	A cellular device inherently has a telephone number

with components of a wireless environment that are coupled to an instant message system, said text message including a destination address, information associated with the cellular communications device's user, message content and message address;		
according to information previously stored for the cellular communications device's user at the instant message system, if the destination address is associated with an instant message function, executing the associated instant message function at the instant message system	determining an instant message identifier associated with the telephone number;	Telephone number addressed above

using the information contained in the message content, if required as determined by the associated instant message function;		
and if the destination address is associated with an instant message user name, creating an instant text message comprising the message content and sending the created instant text message to the associated instant message name.	determining whether an instant message receiver is available to receive messages addressed to the instant message identifier; forwarding the electronic message as an instant message addressed to the instant message identifier in response to a determination that an instant message receiver is available to receive instant messages addressed to the instant message identifier; and	If is equivalent to determining
	sending the electronic	One of skill in the art that it

	message to a mobile device at the telephone number in response to a determination that no instant message receiver is available to receive instant messages addressed to the instant message identifier.	is well known to forward message is the IM user in “away” mode
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***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-61 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. The claim fail to produce according to all possible scenarios a “specific machine to produce a useful, concrete, and tangible result.” Presently the computer does not produce a tangible result the entire processing is done within a single computer and therefore no tangible result is created.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-61 are rejected under 35 U.S.C. 102(b) as being anticipated by Mache et al. (U.S. Patent Application Publication 2001/0003202).

For claim 1, Mache teaches, a method of transmitting electronic messages in a computer environment, comprising the steps of:

receiving an electronic message addressed to a telephone number; (Mache, figures 4,5, paragraph 34, 73, 77)

determining an instant message identifier associated with the telephone number; (Mache, paragraph 53)

determining whether an instant message receiver is available to receive messages addressed to the instant message identifier; (Mache, paragraph 51)

performing a step from a group of steps consisting of: forwarding the electronic message as an instant message addressed to the instant message identifier in response to a determination that an instant message receiver is available to receive instant messages addressed to the instant message identifier; (Mache, paragraphs 19, 57)



and sending the electronic message to a mobile device at the telephone number in response to a determination that no instant message receiver is available to receive instant messages addressed to the instant message identifier. (Mache, paragraphs 21, 57)

For claim 2, Mache teaches, wherein the electronic message comprises any of:  
a text message, an SMS text message, an MMS message, a video message, and an audio message. (Mache, paragraphs 3, 34)

For claim 3, Mache teaches, wherein the instant message is received at an electronic device configured to receive instant messages addressed to the instant message identifier. (Mache, paragraph 76)

For claim 4, Mache teaches, wherein the electronic device comprises any of:  
a computer, a personal data assistant (PDA), and a telephone receiver.  
(Mache, paragraph 104)

For claim 5, Mache teaches, wherein the determining the instant message identifier comprises searching for the instant message identifier associated with the telephone number in a database. (Mache, paragraphs 9, 49, 73)

For claim 6, Mache teaches, further comprising the step of:

determining whether or not to forward the electronic message as an email message addressed to an email address according to a user preference stored in a database. (Mache, paragraph 57)

For claim 7, Mache teaches, further comprising the step of:  
determining whether or not to forward the electronic message as an instant message addressed to the instant message identifier according to a user preference stored in a database. (Mache, paragraphs 57, 67, 70)

For claim 8, Mache teaches, wherein the determining whether or not to forward is further based on source information of the electronic message. (Mache, paragraphs 73, 126, 141)

For claim 9, Mache teaches, wherein the source information comprises any of:  
a source address of the electronic message, a user name of a sender of the electronic message, a telephone number of a sender of the electronic message, and an instant message identifier of a sender of the electronic message. (Mache, paragraph 73)

For claim 10, Mache teaches, wherein the instant message is generated from the electronic message based on one or more predetermined rules. (Mache, paragraphs 93, 141)

For claim 11, Mache teaches, wherein the one or more predetermined rules select one or more portions of the electronic message as the instant message. (Mache, paragraph 141)

For claim 12, Mache teaches, wherein the one or more predetermined rules selectively delete one or more portions of the electronic message to generate the instant message. (Mache, paragraph 65)

For claim 13, Mache teaches, further including the step of forwarding the electronic message to a storage medium. (Mache, paragraph 111)

For claim 14, Mache teaches, further including the step of storing the electronic message in the storage medium. (Mache, paragraph 111)

For claim 15, Mache teaches, further comprising the step of:  
determining whether or not to forward the electronic message to the storage medium according to the user preference stored in the database. (Mache, paragraph 57)

For claim 16, Mache teaches, further comprising the step of:

forwarding the electronic message to the storage medium when the forwarding to the mail address and the instant message identifier fails (Mache, paragraph 93)

For claim 17, Mache teaches, wherein the determining whether or not to forward is further based on source information of the electronic message. (Mache, paragraph 87, 143)

For claim 18, Mache teaches, the method of claim 15, wherein the user preference stored in the database includes date and time preference of the instant message receiver. (Mache, paragraph 83)

For claim 19, Mache teaches, the method of claim 1, further includes the step of logging the forwarding the electronic message. (Mache, paragraph 93)

For claim 20, Mache teaches, the method of claim 1, further includes blocking the forwarding of the electronic messages based on a list of telephone numbers. (Mache, paragraph 131)

For claim 21, Mache teaches, the method of claim 1, wherein the forwarding is based on the one or more predetermined rules. (Mache, paragraph 93)

Claims 22-61 list all the same elements of claims 1-21, but in system and medium form rather than method form. Therefore, the supporting rationale of the rejection to claims 1-22 applies equally as well to claims 22-61.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached UPSTO 892 (if appropriate).

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ajay M. Bhatia whose telephone number is (571)-272-3906. The examiner can normally be reached on M-F 8:30 am - 5:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571)272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jason Cardone  
Supervisor Patent Examiner  
Art Unit 2145

AB